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EXAMINER				
ABEDIN, SHANTO				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,229

Applicant(s)

KENRICH ET AL

Examiner

SHANTO M. ABEDIN

Art Unit

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date 02/13/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the communication filed on 02/13/2009.
2. Claims 1-26 are pending in the application.
3. Claims 1- 26 have been rejected.

Response to Arguments

4. The applicant's arguments regarding previous obvious type double patenting rejections are fully considered, and the previous obvious type double patenting rejections are held in abeyance until the issuance of either the instant application or the copending application.
5. The applicant's arguments regarding the previous 35 USC 101 type rejections are fully considered, the previous 35 USC 101 type rejections are withdrawn because of the amendments made to the claims.
6. The applicant's arguments regarding the 35 USC 102 (e) type rejections of claims 1-7 and 10-26 are fully considered, however, found not persuasive. In particular, upon further examination, cited prior art Ryan was found to teach the limitations set forth by the amended claims (please see the office action below for detail explanations).

In response to the arguments that the reference Ryan fails to disclose the limitations such as document can be accessed only during "finite retention duration", the examiner respectfully disagrees with the applicant. Upon further examination, reference Ryan was found to teach the limitations finite retention duration (Par 037, 038, 045, 051; specific predetermined time limit to access the secure electronic file; time-based access restrictions on the document.)

The examiner notes, although previously withdrawn, upon further examination, claims 8 and 9 are rejected in this office action since reference Ryan was also found to teach the

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limitations set forth by the amended claims 8 and 9. Therefore, claims 1-26 are now remained rejected under 35 USC 102 (c) as anticipated by Ryan reference.

Response to Amendments

7. The amendments to the claims filed on 02/13/2009 are entered, However, they raise new grounds of 35 USC 112, first paragraph type rejection issues (please see office action below for detail explanations)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-3 and 9-38 of copending application no. 10/815251.

In particular, claims 1-12 and 21-24 of the instant application are unpatentable over claims 1-3, 9-11 and 29-37 of the copending application 10/815251; and claims 13-20 and 25-26 are unpatentable over claims 1-3, 9-28 and 33-36 of the copending application 10/815251.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

Difference between the conflicting claims of the instant application and the conflicting claims of the copending application is that the conflicting claim set of the instant application are recited over the one or more claims of the copending application. Furthermore, while copending application claim set recites "retention policy" as specifying data retention period based on future scheduled event, the instant application recites the "retention policy" in terms of retention schedule.

However, at the time of invention, it would have been obvious to a person of ordinary skill in the art to design a method/ system wherein features are described differently in order to provide an alternative embodiment for the claimed invention.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-28 of copending application no. 10/676850.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

Difference between the conflicting claims of the instant application and the conflicting claims of the copending application is that the conflicting claim set of the instant application

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are recited over the one or more claims of the copending application. Furthermore, while conflicting claims of the copending application claim set recite “access restrictions”, the instant application claim set recites such restrictions as part of retention policies.

However, at the time of invention, it would have been obvious to a person of ordinary skill in the art to design a method/ system wherein features are described differently in order to provide an alternative embodiment for the claimed invention.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 25-26, languages of the claims recite the limitations such as “computer-readable storage medium configured to store a plurality of cryptographic key pairs” were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Although the specifications provide support for key storage, NOWHERE in the specification a “computer-readable storage medium” to store keys are disclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-26 are rejected under 35 USC 102 (e) as being anticipated by Ryan (US 2005/0071657 A1).

Regarding claim 1, Ryan discloses a method of providing automated document retention for an electronic document comprising:

assigning a document retention policy to the electronic document [Fig 7; Par 011, 029, 037, 051, 065; determining document access restrictions/ policies/ rules, or security information related to the document retention] , the document retention policy being derived from a recurring cut-off retention schedule specifying cut-off periods, each of the respective installment periods cut-off period having a respective finite document retention duration associated therewith [Fig 5; Par 013, 037-038, 060; policy associated with the time based document access restriction; requiring a new time based restrictions/ rules/ policy for the document retention, or access to the document; associated specific predetermined, and future/ new time period for document retention or access] and

encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during finite retention durations. [Par 029, 037-038, 047, 051-052; encrypting the electronic document/ file; document access dependent on the predetermined time based access restriction/ rules/ policy or security information, or key]

Regarding claim 2, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses the method wherein the encrypting the electronic document comprises encrypting using cryptographic keys associated with particular cut-off periods and associated retention durations [Par 016, 037-038, 045, 051-053; encrypting the electronic document/ file using the cryptographic keys associated with specific predetermined time, or expiring time.]

Regarding claim 3, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses wherein encrypting the electronic document comprises encrypting using a cryptographic key associated with each particular cut-off period and its associated retention duration [Fig 3B; Par 027, 037-038, 042, 045, 051-053; time based access to the document and key; cryptographic keys associated with respective predetermined time, or expiring time]

Regarding claim 4, Ryan discloses a method as recited in claim 3, wherein the document retention policy specifies a document retention period that expires a predetermined period of time after a beginning of it's respective cutoff period [Par 029, 037-038, 045, 051-

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053, 065; policy associated with the time based access restriction; predetermined or new time slot associated with each time based retention key].

Regarding claim 5, Ryan discloses a method as recited in claim 3, wherein the each respective cutoff period corresponds to a maximum off-line period of a client [Par 029, 037-038, 053, predetermined or new time slot associated with each time based retention key]

Regarding claim 6, Ryan discloses a method as recited in claim 1, wherein said encrypting comprises acquiring a cryptographic key from a server over a network, the cryptographic key being used to encrypt the electronic document based on the document retention policy [Fig 3A; Par 013 -017, 035, 041-051, 065; encrypting the document with the key obtained from the server; policy associated with the time based access restriction; time based access/ retention key]

Regarding claim 7, it is rejected applying as above rejecting claim 1 and 6, furthermore, *Ryan* discloses a method as recited in claim 6, wherein said method further comprises: deactivating the cryptographic key when respective document retention duration has expired, thereby preventing further access to the electronic document [Par 017, 037-038, 046, 051, 060; expiring predetermined retention/ access time associated with the time based keys]

Regarding claim 8, Ryan discloses a method as recited in claim 7, wherein said encrypting uses a cryptographic key to encrypt the electronic document based on the

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document retention policy [Par 011, 027, 013, 037-038, 051; encrypting documents according to the access restrictions/ policies/ rules, or security information related to the document retention] , and

the document retention policy specifies respective document retention durations and cut-off periods [Par 011, 037-038, 051, 060; policy associated with the time based document access restriction; associated specific predetermined, and future/ new time period for document retention or access] .

Regarding claim 9, Ryan discloses a method wherein the document retention policy specifies the respective document retention duration that expires a predetermined period of time after a beginning of its respective cut-off period [Par 011, 037-038, 060; access restrictions/ policy/ rules or security information associated with the specific predetermined, and future/ new time period for document retention or access]

Regarding claim 10, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses a method of limiting access to an electronic document comprising:

determining whether a cut-off period for a first document retention key has elapsed [Fig 5.512; Par 037-038, 051, 053; determining whether time based access/ retention key is expired/ passed, or whether current time is greater than the predetermined retention/ access time];

generating a next document retention key to be used to encrypt an the electronic document during a next cut-off period, the next document retention key having a finite document retention duration associated therewith [Fig 3A; Fig 5; Par 016, 037-038, 045, 051,

053; generating plurality of the time based access key to encrypt the electronic document; time based access keys having specific predetermined retention time, or predetermined key life associated with them] and

notifying a client of the next document retention key, the electronic document being cryptographically accessible only during finite document retention durations using a cryptographic key associated with such durations [Fig 4; Fig 5; Par 016, 037, 038, 051, 053; responding to the client whether document is accessible with the current key, or predetermined time has expired].

Regarding claim 11, Ryan discloses the method further comprising:

deactivating the prior document retention key when the prior document retention a cryptographic key is to be deactivated according to a predetermined schedule [Par 017, 037-038, 046, 051, 060; expiring predetermined retention/ access time associated with the time based keys]

Regarding claim 12, Ryan discloses the method wherein the document retention duration is a predetermined duration of time following a beginning of the next installment cut-off period [Par 011, 037-038, 060; access restrictions/ policy/ rules or security information associated with the specific predetermined, and future/ new time period for document retention or access]

Regarding claim 13, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses a method for restricting access to an electronic document, said method comprising:

encrypting a data portion of the electronic document using a document key to produce an encrypted data portion [Fig 4; Fig 7; Par 037, 047-052; encrypting/ securing the document with the cryptographic key];

using a retention access key to associate a document retention policy with the electronic document [Par 013, 0017, 037-038, 051-053, 065; time based restrictions/ policy, and key; new time based access key; expiring predetermined access];

encrypting the document key using the retention access key to produce an encrypted document key [Fig 3B; Par 037-038, 047, 053; expiring predetermined retention/ access time, and using a new time based access key; encrypting the document with a predetermined/ new time based access/ encryption key], the retention access key being usable for said encrypting during a cut-off period of a recurring cut-off retention schedule, the cut-off period having a finite document retention duration associated therewith [Fig 3B; Par 037-038, 046, 051-053; policy/ rules associated with the time based access restriction; user having one or more keys associated with the predetermined time to expire; requiring a new time based key for retention/ access to the document];

forming a secured electronic document from at least the encrypted data portion and the encrypted document key [Fig 4, 7; Par 047, 051-053; encrypted or securing the document]; and

storing the secured electronic document, the secured electronic document being cryptographically accessible only during the finite document retention duration [Par 037-038, 045-051, 061; secure document storage; time based document access].

Regarding claim 14, Ryan discloses the method as recited in claim 13, wherein the retention access key is a public retention access key [Par 037, 047-052; encrypting/ securing the document with the public key]

Regarding claim 15, Ryan discloses the method as recited in claim 13, wherein the document retention policy specifies a the document retention duration that expires a predetermined period of time after a beginning of the installment its cut-off period [Par 017, 037-038, 046, 051, 060; expiring predetermined retention/ access time associated with the time based keys .]

Regarding claim 16, it is rejected applying as above rejecting claim 1 and 13, furthermore, Ryan discloses a method for accessing a secured electronic document, the secured electronic document having at least a header portion and a data portion, comprising: obtaining a retention access key, the retention access key being used to associate a finite document retention duration of a document retention policy having a cut-off period associated therewith with the electronic document, the retention access key being usable during the document retention [Par 037-038, 046, 051-053; policy associated with the time based access restriction; user having one or more keys associated with the predetermined time to expire ; requiring a new time based access key for retention/ access to the document for each specific predetermined/ future/ new time period]

duration following a beginning of a respective installment its respective cut-off period of a periodic installment recurring cut-off retention schedule, the secured electronic document

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being cryptographically accessible only during the finite document retention duration [Par 011, 037-038, 060; access restrictions/ policy/ rules or security information associated with the specific predetermined, and future/ new time period for document retention or access];

obtaining an encrypted document key from the header portion of the secured electronic document [Fig 4; Fig 7; Par 047-053; encrypting or securing the document with the retention key obtained from each document/ header];

decrypting the encrypted document key using the retention access key to produce a document key [Par 047-053, 060; decrypting the encrypted document with the time based access key]; and

decrypting an encrypted data portion of the secured electronic document using the document key to produce a data portion [Par 047-053, 060; decrypting the encrypted document].

Regarding claim 17, Ryan discloses a method as recited in claim 16, wherein the retention access key is identified by an indicator within a header portion of the secured electronic document [Fig 7; Par 0047-0053; obtaining document or file access key from header]

Regarding claim 18, Ryan discloses a method as recited in claim 16, wherein the retention access key is a private retention access key [Fig 3A; Fig 7; Par 047-053; private/ public access key pair].

Regarding claims 21, Ryan discloses a tangible computer-readable medium having stored thereon, computer readable instructions that, if executed by a computing device, cause the computing device to perform a method comprising:

assigning a document retention policy to the electronic document [Fig 7; Par 011, 029, 037, 051, 065; determining document access restrictions/ policies/ rules, or security information related to the document retention] , the document retention policy being derived from a recurring cut-off retention schedule specifying cut-off periods, each of the respective installment periods cut-off period having a respective finite document retention duration associated therewith [Fig 5; Par 013, 037-038, 060; policy associated with the time based document access restriction; requiring a new time based restrictions/ rules/ policy for the document retention, or access to the document; associated specific predetermined, and future/ new time period for document retention or access] and

encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during finite retention durations. [Par 029, 037-038, 047, 051-052; encrypting the electronic document/ file; document access dependent on the predetermined time based access restriction/ rules/ policy or security information, or key]

Regarding claims 25, Ryan discloses a computer-implemented file security system for restricting access to an electronic file, comprising:

a computer-readable storage medium [Fig 1.106; Par 013, 038; key storage] configured to store a plurality of cryptographic key pairs, each of the cryptographic key pairs including a public key and a private key, at least one of the cryptographic key pairs pertaining to a

retention policy [Fig 7.726, 729, 730; Par 011, 013, 038, 060; time based access key is associated with the restrictions/ rules on the document], the retention policy having a respective finite document retention durations and a finite document retention duration having a respective cut off period associated therewith [Fig 5; Par 013, 037-038, 060; policy associated with the time based document access restriction; requiring a new time based restrictions/ rules/ policy for the document retention, or access to the document; associated specific predetermined, and future/ new time period for document retention or access]; and an access manager [Par 016, 027, 035, 051; access server, or key distributing/ security system] operatively connected to said key store, said access manager configured control management module which if executed by a computing device of the computer-implemented file security system, causes the computing device to:

provide, for each of the respective installment particular cut-off period, a different one of the public keys of the at least one of the cryptographic key pairs[Par 016, 035-038, 045, 053; different cryptographic keys for each predetermined time associated with document access], and

determine whether the private key of the at least one of the cryptographic key pairs pertaining to the retention policy is permitted to be provided to a requestor based on whether it's respective document retention duration following a beginning of it's respective installment cut-off period has expired [Par 011, 016, 037-038, 051, 060; policy associated with the time based access restriction; expiring time, or predetermined or new time slot associated with each time based retention key.]

wherein the requestor requires the private key of the at least one of the cryptographic key pairs pertaining to the retention policy to access a secured electronic file, and wherein the

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secured electronic file was previously secured using the public key of the at least one of the cryptographic key pairs pertaining to the retention policy [Par 027, 037-038, 045, 051-052; time based cryptographic key pair associated with the document access restrictions/ rules or policy] , and at the time the electronic file was so secured, the public key was within its respective cut-off period and available for use, the secured electronic document being cryptographically accessible only during the finite retention durations [Fig 7; Par 027, 037-038, 045, 051, 065; time based cryptographic key, and time based document access restrictions/ rules or policy] .

Regarding claims 19-20, 22-24 and 26, they recite the limitations of claims 4-7, 17-18 and 25, therefore, they are rejected applying as above rejecting claims 4-7, 17-18 and 25.

Conclusion

12. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Finally, for any future amendments to claims, the applicant is respectfully suggested to incorporate the paragraph numbers from the specification upon which the support for such amendments were dependent on.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 10:00 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Abedin

Examiner, AU 2436

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2436